ESTTA Tracking number:

ESTTA492899

Filing date:

09/06/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206545
Party	Defendant French Douglas, Kohlberg
Correspondence Address	SHERYL DE LUCA NIXON & VANDERHYE P.C. 901 N. GLEBE ROAD 11TH FLOOR ARLINGTON, VA 22203-1808 nixonptomail@nixonvan.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Sheryl De Luca
Filer's e-mail	nixonptomail@nixonvan.com, sld@nixonvan.com
Signature	/Sheryl De Luca/
Date	09/06/2012
Attachments	5120-3 motion to dismiss.pdf (15 pages)(712441 bytes)

RODRIGORODRIGUEZ)	5120-3
Opposer, v. FRENCH DOUGLAS, KOHLBERG Applicant.)) Opposition No. 91206545) Application No. 78/586,170) Mark: SCORPION & design)	
Box TTAB NO FEE Commissioner for Trademarks P.O. Box 1451 Arlington, Virginia 22313-1451		

APPLICANT'S MOTION TO DISMISS FOR INSUFFICIENT SERVICE

Pursuant to Rule 12(b)(5) of the Federal Rules of Civil Procedure and Trademark Rules of Practice 2.101 and 2.127, Applicant, Douglas Kohlberg French hereby moves to dismiss the Notice of Opposition filed by Opposer RodroRodriguez.

Applicant is the owner of Application No. 78/586,170, which is the application at issue in this proceeding (for SCORPION & Design). Since Opposer failed to serve a copy of its Notice of Opposition on Applicant or counsel for Applicant as expressly required by the Trademark Rules of Practice and precedent established by the TTAB, the opposition has not been properly instituted and should be dismissed.¹

¹ See Trademark Rule 2.116(a), which makes applicable to this proceeding the defense of insufficient service of process under FRCP 12(b)(5); Chocoladefabriken Lindt & Sprungli Ag v. Flores, 91 USPQ2d 1698, 1699 (TTAB 2009) (indicating that the affirmative defense of insufficient service may be presented by motion to be filed prior to, or concurrently with, the defendant's answer).

STATEMENT OF FACTS

Douglas Kohlberg French is the owner of the Application at issue in this proceeding. The undersigned is the counsel of record to which correspondence is to be addressed. See Exhibit A, the USPTO's Trademark Status and Document Retrieval ("TSDR") record for Application No. 78/586,170.

On August 2, 2012, Opposer, Rodrigo Rodriguez Islas filed a 30-day request for an extension of time to file a notice of opposition, which was granted by the Board through September 1, 2012.

On August 14, 2012, Opposer, through the Board's Electronic System for Trademark Trials and Appeals ("ESTTA"), filed a Notice of Opposition against Applicant. The Opposer's ESTTA filing included a certification that "a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date," which was signed with Applicant's electronic signature.

However, Opposer never contacted Applicant or Applicant's counsel at all regarding this matter, and certainly not regarding whether Applicant would agree to electronic service of a notice of opposition (by Facsimile or email). See Exhibit B, Declaration of Sheryl De Luca., ¶2; Exhibit B, Declaration of Douglas K. French Decl. ¶2. Further, Applicant or Applicant's counsel never received a service copy of the notice of opposition by facsimile, email or any other means whatsoever. De Luca. Decl, ¶¶3, 4; French Decl. ¶¶3, 4.

There is no opposition period remaining. The extension of time to oppose expired on September 1, 2012 (effectively September 4, 2012).

ARGUMENT

Opposer has incurably failed to make any actual service of the notice of opposition as required by the Trademark Rules and precedents. Opposer further inaccurately certified to the TTAB that (1) it had consent from the Applicant regarding service by electronic transmission (as required by Trademark Rule 2.119 (b)(6)); and (2) that it made the service. Accordingly, the opposition proceeding should be dismissed.

Trademark Rule of Practice 2.101(a) provides as follows (emphasis added):

An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. *The notice must include proof of service on the applicant, or its attorney* or domestic representative of record, at the correspondence address of record in the Office, . . .

37 C.F.R. § 2.101(a). Including a signed proof of service with the Notice of Opposition document (as is the case with ESTTA filings), without actually effecting service according to the rules is insufficient to commence an opposition proceeding. See Springfield Inc. v. XD, 86 USPQ2d 1063, 1064 (TTAB 2008) ("The proof of service requirement assumes actual service on applicant, or its attorney . . . Proof of service is meaningless in the absence of actual service in accordance with the statements contained in the proof of service. The requirement of the rules is for proof of service, not a promise to make service at some time in the future.")²

² See also Equine Touch Foundation Inc. v. Equinology Inc., 91 USPQ2d 1943, 1944, n. 5 (TTAB 2009) ("Actual forwarding of the service copy, however, is the responsibility of the filer, as ESTTA does not effect service for the filer."); Jaques Moret Inc. v. Speedco Holdings B.V., 102 USQ2d 1212, 1214 (TTAB 2012) (petition to cancel dismissed because of insufficient service of process: "ESTTA requires a petitioner to affirmatively represent to the Board that it has served a copy of the petition for cancellation on respondent, and to select the method by which the petitioner serves respondent; . . . a statement confirming service appears on the ESTTA-generated filing form as part of the

Further, Trademark Rule 2.101(b) requires that a copy of the notice of opposition (along with any exhibits) must be served on the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office. 37 C.F.R. § 2.101(b); *Springfield Inc.*, 86 USPQ2d at 1064 (opposition "dismissed as a nullity" where "opposer did not comply with the service requirement of the rules.").

Since Opposer served neither Applicant nor counsel of record at the correspondence address of record listed in the Office records with the Notice of Opposition, an opposition proceeding has not been properly instituted. In circumstances where, as is the case here, the Opposer did not make sufficient efforts to serve the notice of opposition and where there is no opposition period remaining, the TTAB has found that the opposition should not have been accorded a filing date and must be considered a nullity. See Id. ("the notice of opposition included proof of service, but there was not actual service on applicant.... Accordingly, opposer's notice of opposition should not have received a filing date, and this proceeding should not have been instituted."); Schott AG v. Scott, 8 USPQ2d 1862, 1864 (TTAB 2008), which granted Applicant's motions to dismiss oppositions for opposer's failure to comply with service requirements:

[O]pposer cannot, by filing amended notices, cure its failure to properly serve the original notices of opposition. A notice of opposition can be amended as of right only if the original notice of opposition was proper. Because the original notices . . . were not properly served in a timely

compliant. However, the recitation of service on the complaint does not by itself effect service; petitioner must still make actual service of the complaint on respondent to comply with its service obligation. . . . Attesting to proof of service of an ESTTA filing without actually effecting service in accordance with the rules is insufficient to commence the proceeding.")

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manner, each of the oppositions must be dismissed as a nullity. There are, therefore, no operative notices of opposition to amend. Moreover, the amended notices of opposition cannot be used as a substitute for the original notices of opposition because, . . . [they] were not filed within the opposition period, as extended.

Id. at 1864. See also *Equine Touch Foundation Inc.,* 91 USPQ2d at 1944, which reasoned:

The time for filing a notice of opposition is statutory and cannot be waived by the Board; and the filing date for a notice of opposition is dependent on, among other things, forwarding of a service copy and inclusion of proof of service when the opposition is filed. Thus, if opposer's service of a notice of opposition, or its submission of proof of service, occurs after the close of the opposition period, including any granted extensions, the filing date would fall outside the opposition period and the Board would refuse the opposition as untimely.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board dismiss the present Opposition proceeding for improper service.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

Sheryl De Luca

SLD:sld 901 North Glebe Road, 11th Floor Arlington, VA 22203-1808 Telephone: (703) 816-4000

Facsimile: (703) 816-4100

CERTIFICATE OF SERVICE

I hereby certify that on September 6, 2012, the foregoing APPLICANT'S

MOTION TO DISMISS FOR INSUFFICIENT SERVICE was served on Opposer via first-class mail to:

Rodrigo Rodriguez Islas 395 Sawdust Rd 2192 Spring, Texas 77380

NIXON & VANDERHYE, PC

Bv

Sheryl De Luca

901 North Glebe Rd.

11th Floor

Arlington, VA 22208-1808

Phone: 703-816-4022 Fax: 703-816-4100

RODRIGORODRIGUEZ)	5120-3
Opposer,))) Opposition No. 91206545	
٧.) Opposition No. 91200343	
FRENCH DOUGLAS, KOHLBERG Applicant.))	

EXHIBIT A

TO

APPLICANT'S MOTION TO DISMISS FOR INSUFFICIENT SERVICE

STATUS

DOCUMENTS

Back to Search

W 85 86

Print

Generated on: This page was generated by TSDR on 2012-09-04 12:09:08 EST

Mark: SCORPION



US Serial Number: 78586170

Application Filing Date: Mar. 13, 2005

Register: Principal

Mark Type: Trademark

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVUE on the

Trademark Trial and Appeal Board web page.

Status Date: Aug. 14, 2012

Publication Date: Jul. 03, 2012

Mark Information

♣ Collapse All

Mark Literal Elements: SCORPION

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of a rectangle, having an upper concave portion in the color RED and a lower larger convex portion in the color

YELLOW. The word "SCORPION" in the color BLACK appears in the red portion of the rectangle. A drawing of a scorpion in the color

BLACK appears in the YELLOW portion of the rectangle. A scroll border in the color BLACK surrounds the rectangle.

Color Drawing: Yes

Color(s) Claimed: The color(s) red, black and yellow is/are claimed as a feature of the mark.

Design Search Code(s): 03.23.05 - Scorpions

03.23.24 - Stylized insects, spiders and micro-organisms

26.11.07 - Rectangles with a decorative border, including scalloped, ruffled and zig-zag edges

26.11.20 - Rectangles inside one another

26.11.21 - Rectangles that are completely or partially shaded

26.11.25 - Rectangles with one or more curved sides

Related Properties Information

Claimed Ownership of US 3841502

Registrations:

Foreign Information

Foreign Registration 630341 Number: Foreign Registration Date: May 28, 2004

Foreign MEXICO

Foreign Expiration Date: May 26, 2014

Application/Registration

Country:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [..] indicate deleted goods/services;
- * Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks ".." identify additional (new) wording in the goods/services.

For: Alcoholic beverages, namely, Distilled Spirits

International Class: 033 - Primary Class

U.S Class: 047, 049

Class Status: ACTIVE

Basis: 1(a) 44(e)

▼ Basis Information (Case Level)

Filed Use: Yes Currently Use: Yes Amended Use: No Filed ITU: No Currently ITU: No Amended ITU: No Filed 44D: No Currently 44D: No Amended 44D: No Filed 44E: Yes Currently 44E: Yes Amended 44E: No

Filed 66A: No Currently 66A: No

Filed No Basis: No Currently No Basis: No

⋆ Current Owner(s) Information

Owner Name: French Douglas, Kohlberg

Owner Address: Apartado 252

Oaxaca, OHIO 44017 UNITED STATES

Legal Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Sheryl De Luca

Docket Number: SLD-5120-3

Correspondent

Correspondent SHERYL DE LUCA
Name/Address: NIXON & VANDERHYE P.C.

901 N. GLEBE ROAD 11TH FLOOR ARLINGTON, VIRGINIA 22203-1808

Phone: (703) 816-4000

Fax: (703) 816-4100

Correspondent e-mail: nixonptomail@nixonvan.com

Correspondent e-mail Yes Authorized:

Domestic Representative - Not Found

- Prosecution History

Date	Description	Proceeding Number
Aug. 14, 2012	OPPOSITION INSTITUTED NO. 999999	206545
Aug. 02, 2012	EXTENSION OF TIME TO OPPOSE RECEIVED	
Jul. 03, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 03, 2012	PUBLISHED FOR OPPOSITION	
Jun. 13, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 31, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
May 31, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 09, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	66213
May 09, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	66213
Apr. 19, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 13, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 13, 2012	NON-FINAL ACTION E-MAILED	6325
Apr. 13, 2012	NON-FINAL ACTION WRITTEN	77300
Mar. 22, 2012	AMENDMENT FROM APPLICANT ENTERED	66213
Mar. 22, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	66213
Mar. 12, 2012	PAPER RECEIVED	
Sep. 14, 2011	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 14, 2011	NON-FINAL ACTION E-MAILED	6325
Sep. 14, 2011	NON-FINAL ACTION WRITTEN	77300
Aug. 16, 2011	AMENDMENT FROM APPLICANT ENTERED	66213

United States Patent & Trademark ...

Page 3 of 3

Aug. 16, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	66213
Aug. 16, 2011	ASSIGNED TO LIE	66213
Aug. 05, 2011	PAPER RECEIVED	
Aug. 05, 2011	ATTORNEY REVOKED AND/OR APPOINTED	
Aug. 05, 2011	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jan. 07, 2008	ASSIGNED TO EXAMINER	77300
Mar. 28, 2007	REPORT UNRESPONSIVE AMENDMENT - COMPLETED	73375
Mar. 02, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 01, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
'Mar. 01, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Feb. 01, 2007	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	
Aug. 01, 2006	LETTER OF SUSPENSION E-MAILED	6332
Aug. 01, 2006	SUSPENSION LETTER WRITTEN	73375
Jun. 19, 2006	TEAS/EMAIL CORRESPONDENCE ENTERED	70138
Jun. 11, 2006	CORRESPONDENCE RECEIVED IN LAW OFFICE	70138
Jun. 11, 2006	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 01, 2006	LETTER OF SUSPENSION E-MAILED	6332
Jun. 01, 2006	SUSPENSION LETTER WRITTEN	73375
Mar. 29, 2006	TEAS/EMAIL CORRESPONDENCE ENTERED	78145
Mar. 19, 2006	CORRESPONDENCE RECEIVED IN LAW OFFICE	78145
Mar. 19, 2006	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 19, 2006	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 30, 2005	NON-FINAL ACTION E-MAILED	6325
Sep. 30, 2005	NON-FINAL ACTION WRITTEN	73375
Sep. 29, 2005	ASSIGNED TO EXAMINER	73375
Mar. 18, 2005	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: CLAYTON, CHERYL A

Law Office Assigned: LAW OFFICE 102

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 31, 2012

RODRIGORODRIGUEZ)	5120-3
Opposer,))) Opposition No. 91206545	
V.)	
FRENCH DOUGLAS, KOHLBERG Applicant.))	

EXHIBIT B

TO

APPLICANT'S MOTION TO DISMISS FOR INSUFFICIENT SERVICE

RODRIGORODRIGUEZ)	5120-3
Opposer,))) Opposition No. 91206545	
V.)	
FRENCH DOUGLAS, KOHLBERG Applicant.))	

DECLARATION OF SHERYL DE LUCA

- I, Sheryl L. De Luca, declare as follows:
- 1. I am a member of Nixon & Vanderhye P.C. and a member of the bar of the Commonwealth of Virginia. I make this declaration based on personal knowledge as to the matters set forth below, in support of Applicant, Douglas Kohlberg French's Motion to Dismiss this proceeding.
- 2. To date, Opposer never contacted me to obtain permission to receive electronic service of a Notice of Opposition, e.g., by facsimile or email. To date, Opposer has not contacted me for any reason.
- 3. To date, I did not, nor did my firm, receive any service copies of the Notice of Opposition in this case from the Opposer.
- 4. I am unaware of any efforts Opposer may have made to serve Applicant or me with the Notice of Opposition in this proceeding.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge, information and belief.

Executed on <u>September 6, 2012</u> <u>Sheryl De Luca</u>

Sheryl De Luca

RODRIGORODRIGUEZ)	5120-3
Opposer,))) Opposition No. 91206545	
V.		
FRENCH DOUGLAS, KOHLBERG Applicant.)))	

EXHIBIT C

TO

APPLICANT'S MOTION TO DISMISS FOR INSUFFICIENT SERVICE

RODRIGORODRIGUEZ)	5120-3
Opposer,)	
V.) Opposition No. 91206545)	
FRENCH DOUGLAS, KOHLBERG Applicant.)	

DECLARATION OF DOUGLAS KOHLBERG FRENCH

- I, Douglas Kohlberg French, declare as follows:
- 1. That I am the Applicant and am authorized to execute this declaration.
- To date, Opposer never contacted me to obtain permission to receive service of a Notice of Opposition by facsimile or email. To date, Opposer has not contacted me for any reason.
- 3. To date, I did not receive any service copies of the Notice of Opposition in this case from the Opposer.
- 4. I am unaware of any efforts Opposer may have made to serve me or my attorney or record in this case with the Notice of Opposition in this proceeding.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge, information and belief.

Executed on Sept 5,2012

Døuglas Køhlberg French